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REMARKS

Claims 1-7, 9-13, 16-17, 19, 21-23, and 25-27 are currently pending in the subject application and are presently under consideration. Applicant's representative notes with appreciation the indication that claims 4, 9-10, 12-13, 16-17, 19, and 25-27 would be allowable if recast in independent form, including limitations of the base claim and intervening claims. Given the comments below, however, it is believed that such amendments are unnecessary.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-3, 5-7, 11, and 21-23 Under 35 U.S.C. §103(a)

Claims 1-3, 5-7, 11, and 21-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Prince (US 5,617,113) in view of Muhich, *et al.* (US 4,706,074).

Withdrawal of this rejection is respectfully requested for at least the following reasons.

Prince and Muhich, *et al.*, either alone or in combination, fail to teach or suggest each and every aspect as recited in the subject claims. Further, there is no motivation found within the cited references to combine such references.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed invention reduces computational overhead required in conventional dual scan display cursor systems, which employ software to position a cursor image (in

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contrast to hardware). To that end, independent claim 1 recites *a hardware cursor that selectively overlays a cursor image across a display boundary onto first and second display portions... of a dual scan display* (independent claims 5 and 21 recite similar aspects). Neither Prince nor Muhich, *et al.* disclose, teach, or suggest such claimed aspects.

Prince relates to configuring multiple memory portions so as to reduce an amount of memory required for implementation of dual scan displays. The configuration utilizes three disparate memory areas, wherein each memory area can at least temporarily store a half frame buffer. In more detail, as disclosed in Prince, two of the memory areas (or buffers) can include complete display information with respect to one display region of a dual-scan display, wherein such information can include image data and/or column signal data for particular sections of the display. (See Abstract). Based upon the foregoing, the Examiner asserts that *a hardware cursor that selectively overlays a cursor image across a display boundary onto first and second display portions... of a dual scan display* is inherently disclosed by Prince. The Examiner bases this rationale on the broad statement “a hardware cursor, that is an image cursor should cross onto the display...” (See Office Action dated September 7, 2005). Applicant’s representative submits that this broad statement fails to satisfy the Examiner’s burden for establishing inherency.

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Mehl/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh’g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 27, 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Prince does not disclose use of any sort of cursor in connection with a dual scan display (e.g., the term “cursor” is not utilized once within Prince). In fact, one could conjecture that the dual scan display disclosed in Prince may have been intended for use as a television display, in which case there would be no cursor. In another example, software cursors were known at the time of filing of Prince – thus, one of ordinary skill in

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the art may have presupposed that a software cursor may be utilized in connection with the teachings of Prince. To state that use of a hardware cursor may be employed together with the teachings of Prince is at best based upon possibilities, and therefore, in contrast to the Examiner's assertion, a hardware cursor is not inherent given the teachings of Prince. (See *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999)).

The secondary reference employed by the Examiner (Muhich, *et al.*), like Prince, fails to disclose, teach, or suggest ***a hardware cursor that selectively overlays a cursor image across a display boundary onto first and second display portions... of a dual scan display*** as claimed. Rather, Muhich, *et al.* teaches combining cursor data with image data to effectuate display of a cursor on a single scan display. There is no motivation to combine the teachings of Muhich, *et al.*, with Prince, as there is no mention within Muhich, *et al.* regarding the possibility of employing the disclosed system with a dual scan display. Similarly, there is no teaching within Prince of a cursor (much less a hardware cursor) that can be employed in connection with a dual scan display as recited in the subject claims.

Accordingly, in view of at least the above, it is readily apparent that claims 1, 5, and 21 (and all claims that depend therefrom) are allowable over the combination of Prince and Muhich, *et al.* Therefore, withdrawal of this rejection is respectfully requested.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[ALBRP200US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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